

REMARKS

Applicants have carefully reviewed the Office Action dated October 19, 2006, prior to preparing this response. Currently, claims 1-40 and 44 are pending in the application, wherein claims 1-8, 10-15, 19-21, 24-29, 33, 34, 38-40 and 44 have been rejected and claims 9, 16-18, 22, 23, 30-32 and 35-37 have been withdrawn from consideration consequent an Examiner initiated restriction requirement. Claims 1, 10, 24 and 44 have been amended with this paper. No new matter has been added with these amendments. Favorable consideration of the above amendments and following remarks is respectfully requested.

Claim rejections under 35 U.S.C. §112

Claims 1-8 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully disagree with this assertion. Claim 1 recites, in part, “a connector connecting the proximal section and the distal section of the elongate shaft, wherein the connector is fixedly secured to both the proximal section and the distal section, securing the distal end of the proximal section with the proximal end of the distal section.” Applicants assert that one of ordinary skill in the art would recognize the meaning of the language in this claim. This is especially apparent in light of the disclosure contained in the specification. For example, Figure 3 is shown below, pointing out a distal end 64 of a proximal portion 26 and a proximal end 66 of a distal portion 28. A connector 30 is illustrated as “connecting proximal section 26 and distal section 28” (see paragraph [0042] of the published application).

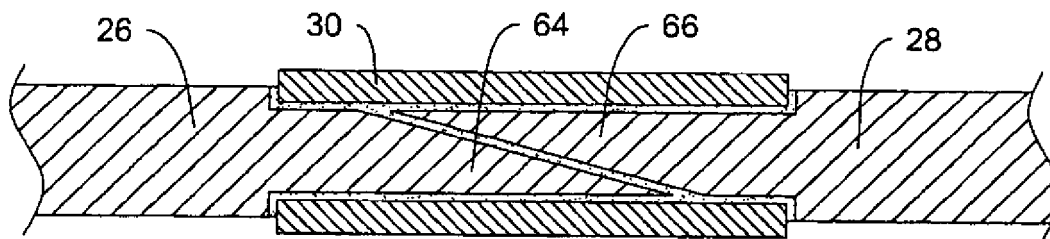


Fig.3

Because this claim language would be clear to one of ordinary skill in the art and because the subject matter is clearly shown in the figures and described in the written portions of the specification, Applicants respectfully assert that the disputed claim language is clear and is supported and explained in the specification. As such, one of ordinary skill in the art would understand the meaning of this claim language. Therefore, Applicants respectfully assert that claim 1, and claims 2-8 which depend therefrom, are in compliance with 35 U.S.C. §112, second paragraph.

Claims rejections under 35 U.S.C. §§ 102

Claims 1-8, 10-15, 19-21, 24-29, 33-34, 38-40 and 44 are rejected under 35 U.S.C. §102(b) as being anticipated by Gilson et al., U.S. Patent No. 6,336,934 (hereinafter “Gilson”). Applicants respectfully traverse this rejection. In order for a reference to anticipate a claim, each and every element of the claim must be present in the reference. See M.P.E.P. §2131.

Figures 13-15 of Gilson, which appear to illustrate an embolic protection device, are relied upon in formulating the rejection. It appears as though the Office Action attempts to equate the tube 32 shown in the Figures of Gilson to the applicants’ claimed connector. Applicants respectfully maintain the teachings of Gilson regarding the tube 32 indicate that Gilson fails to anticipate claim 1. As disclosed in Gilson, “[t]he design consists of a substrate shaft 33 onto which are radially or circumferentially bonded a series of pre-shaped wires 30. The wires 30 are joined on the proximal end into a movable collar or tube 32 mounted on the substrate shaft 33 and at the distal end into a fixed tube 34. The tube 32 can move proximally and distally to the extent that it will open and close the assembly.” See column 10, lines 59-65 (emphasis added).

In contrast, claim 1 recites, in part, a connector connecting the proximal section and the distal section of the elongate shaft, wherein the connector is fixedly secured to both the proximal section and the distal section, securing the distal end of the proximal section with the proximal end of the distal section. The Office Action is apparently equating the tube 32 of Figures 13-15 with the connector of claim 1. However, as emphasized above, the tube 32 is movable along the shaft 33. This is also shown in Figures 13-15, in which the tube 32 is shown moving (see the arrows in Figures 13 and 14 and the change in position of the tube 32).

Moving the tube 32 can apparently move the wires 30 between collapsed and expanded configuration. This moveable tube 32 does not appear to be disclosed as a structure that is fixedly secured to two sections of a shaft, as currently claimed. Therefore, the tube 32 cannot be the connector of claim 1, and all limitations of claim 1 are not disclosed in Gilson. For at least the above reasons, Gilson cannot anticipate claim 1. Because they are dependent on claim 1 and because they contain additional patentably distinct elements, Applicants also assert that claims 2-8 are allowable over Gilson.

Claim 10 recites, among other elements, a core member with a proximal region comprising a first material and a distal region comprising a second material different from the first material and a connector disposed over the distal end of the proximal region and the proximal end of the distal region, the connector fixedly secured to each of the proximal and distal regions of the core member. Applicants assert that multiple portions of claim 10 are not disclosed in Gilson. It appears as though the tube 32 of Figures 11-15 is being equated with the connector of claim 10. As mentioned above, the tube 32 moves back and forth along the shaft 33, apparently in order to cause the wires 30 to move between collapsed and expanded configurations. This moveable tube 32 does not appear to be disclosed as fixedly secured to any portion of a core member. Therefore, the tube 32 cannot be the connector of claim 10, and all elements of claim 10 are not disclosed in Gilson.

In addition, it appears to be asserted in the Office Action that Gilson discloses a proximal section of the shaft 33 that is stainless steel and the distal section that has a second material which is nickel-titanium (the Office Action points to column 11, lines 39-42 in support of this assertion). Applicants respectfully traverse this assertion for at least two reasons. First, column 11, lines 39-42 actually does not describe the shaft 33. Rather, this portion of the specification is making reference to the composition of the frame element 40 of Figures 16 and 17. As such, this portion does not disclose a core member of a filter wire that has a proximal region comprising a first material and a distal region comprising a second material different from the first material.

Further, even if this portion of Gilson disclosed a shaft 33 as asserted by the Examiner, this portion of Gilson is actually describing a separate embodiment from the embodiment described in Figures 11-15. In order for a reference to anticipate a claim, "the identical invention must be shown in as complete detail as is contained in the claim." See M.P.E.P.

§2131. Here, it appears as though the Examiner is attempting to combine structure from the embodiment shown in Figures 11-15 with structure from the embodiment shown in Figures 16 and 17. Applicants respectfully point out that, according to M.P.E.P. §2131, combining elements from two different embodiments in such a manner cannot be used to anticipate a claim. For at least this additional reason, Gilson cannot anticipate claim 10.

Because Gilson does not disclose all elements of claim 10, Applicants assert that claim 10 is allowable over this reference. Because they are dependent on claim 10 and because they recite additional patentably distinct elements, Applicants also assert that claims 11-15 and 19-21 are allowable over Gilson.

In addition, it was asserted in the Office Action that Gilson discloses a connector that “has a third material which is compatible for bonding to both the first and the second material” (the Office Action points to column 13, lines 10-24 in support of this assertion). This statement was apparently made in rejecting dependent claim 13. Applicants respectfully traverse this assertion. This portion of Gilson does not disclose a connector structure at all. This portion of the specification of Gilson is describing the embodiment shown in Figure 29; specifically, this portion of the specification is discussing the olive structure 65 of the embodiment shown in Figure 29. This olive structure 65 does not appear to be disclosed as securing two regions of a core member, and as such it cannot be the connector of claim 10 or claim 13. In addition, according to M.P.E.P. §2131, portions of the embodiment shown in Figure 29 cannot be used in combination with portions of the embodiment shown in Figures 11-15 in order to anticipate claim 13. For at least these additional reasons, Applicants respectfully assert that claim 13 is allowable over Gilson.

Claim 24 was also rejected as being anticipated by Gilson. This claim recites, among other elements, a connector disposed over the distal end of the proximal portion and the proximal end of the distal portion, the connector fixedly secured to each of the proximal and distal portions of the core member. The proximal and distal portions have different flexibilities. Applicants assert that all elements of this claim are not present in Gilson.

It appears as though the Office Action is equating the tube 32 with the connector of claim 24. However, as described above the tube 32 does not appear to be fixedly secured to two portions of a core member at all. As mentioned above, this tube 32 is moveable along the shaft 33, apparently in order to expand (or contract) the wires 30. As such, this tube 32

cannot be the connector of claim 24. Further, it does not appear as though Figures 11-15 of Gilson, or the written description of these figures, discloses a core member of a filter wire that has proximal and distal portions with differing flexibilities. Because at least these elements of claim 24 are not disclosed in Gilson, Applicants respectfully assert that claim 24 is allowable over this reference. Because they are dependent on claim 24 and because they recite additional patentably distinct elements, Applicants also assert that claims 25-29, 33, 34 and 38 are allowable over Gilson.

Claim 39 was also rejected as being anticipated by Gilson. This claim recites, in part, a proximal and distal region of a core member of a filter wire, where the proximal and distal regions comprise differing materials. A means for securing the proximal and distal regions is also provided in the claim. The Office Action apparently points to column 11, lines 39-42 of Gilson in asserting that the Gilson discloses a core member that has proximal and distal regions comprising differing materials. However, again, this portion of Gilson does not disclose the composition of a core member; this portion of Gilson discusses the composition of the frame element 40 of the embodiment of Figures 16 and 17. As such, this portion of Gilson does not disclose a core member with proximal and distal portions comprising differing materials. Further, as mentioned above, according to M.P.E.P §2131, elements of the embodiment shown in Figures 11-15 cannot be combined with elements of the embodiment shown in Figures 16 and 17 to anticipate claim 39. For at least the above reasons, Gilson does not disclose the combination of elements recited in claim 39, and Applicants respectfully assert that this claim is allowable over this reference.

Applicants also assert that Gilson does not disclose a means for securing the proximal and distal regions of claim 39. In order to establish anticipation of a means-plus-function portion of a claim, a prior art element must perform the function specified in the claim, the prior art element must not be excluded as an equivalent by the specification, and the prior art element must be an equivalent of the means-plus-function limitation. See M.P.E.P. §2183.

The means for securing of claim 39 does not appear to be discussed anywhere in the Office Action, and as such the Applicants cannot tell what structure or structures of Gilson are being equated with the means for securing of claim 39. However, Applicants respectfully assert that, as an initial matter, Gilson does not appear to provide any structure that performs the function that is specified in claim 39, and as such it cannot be said that Gilson discloses

the means for securing recited in this claim. For at least this reason, Applicants respectfully assert that Gilson cannot anticipate claim 39.

In fact, Applicants assert that a *prima facie* case has not been made that any structure described in Gilson performs the function of, or is the equivalent of, the means plus function structure recited in claim 39. M.P.E.P. §2183 states that “the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent” (emphasis added). Applicants point out that the means for securing of claim 39 does not appear to have been discussed anywhere in the Office Action; a conclusory statement saying that Gilson discloses the features of claim 39 is not sufficient to make a *prima facie* case that any structure in Gilson performs the same function as, or is equivalent of, the means plus function structures recited in claim 39. For at least the above reasons, Applicants assert that the Examiner has not established that claim 39 is anticipated by Gilson.

Claim 40 recites, in part, a core member of a filter wire that has a proximal portion and a distal portion where the proximal and distal portions have differing flexibilities. A means for blending the first and second flexibilities is also provided. As mentioned above, it does not appear as though anything in Figures 11-15 of Gilson, or the written description thereof, discloses a core member with proximal and distal portions having differing flexibilities. Also, it does not appear as though Gilson discloses a means for blending. The means for blending does not appear to be discussed anywhere in the Office Action, and as such Applicants cannot tell what structure or structures of Gilson are being equated with the means for blending of claim 40. However, Applicants respectfully assert that, as an initial matter, Gilson does not disclose any structure that performs the function specified in claim 40, and as such it cannot be said that Gilson discloses a means for blending of claim 40. For at least this reason, Applicants respectfully assert that Gilson cannot anticipate claim 40.

In fact, M.P.E.P. §2183 states that “the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent” (emphasis added). In this case, the means for blending of claim 40 is not actually discussed anywhere in the Office Action. Applicants assert that this complete lack of discussion of the means portion of claim 40 cannot be sufficient to establish a *prima facie* case that Gilson discloses the means of claim 40. For at least the above reasons, Applicants assert that the Examiner has not established that claim 40 is anticipated by Gilson.

Finally, claim 44 recites, in part, a method including the step of providing a filtering device that includes a connector connecting the proximal section and the distal section of the shaft, wherein the connector is fixedly secured to both the proximal section and the distal section, securing the distal end of the proximal section with the proximal end of the distal section. It appears as though the Office Action is equating the tube 32 of Gilson with the connector of claim 44. As mentioned above, the tube 32 is not fixedly secured two portions of a shaft. As such, all elements of claim 44 are not disclosed in Gilson, and Applicants assert that this claim is allowable over this reference.

Conclusion

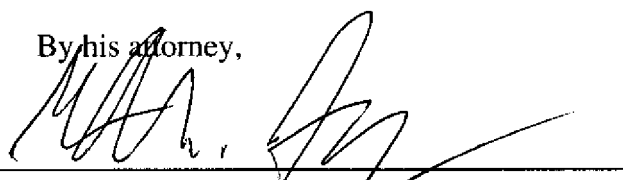
Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his attorney,

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